

### **REMARKS**

Claims 1, 4, 8 and 13 have been amended. Claims 7, 12, 20, 25 and 26 have been canceled. Claims 21-24 have been withdrawn. Claims 1-6, 8-11 and 13-19 remain in the application.

The Applicant would like to thank the Examiner for courtesies extended during the phone interview of October 4, 2007.

Claims 1-11, 13-19 and 25-26 were rejected under 35 U.S.C. §103(a) as being obvious over Kallestad et al. (U.S. Patent 3,943,924) in view of Jones et al. (U.S. Patent 5,746,221) and Daskalon et al. (U.S. Patent 6,533,969). The Applicant respectfully traverses this rejection.

The Kallestad reference discloses a mouthguard having an insert material with an arcuate shape and positioned in an inner wall of the mouthguard behind the tooth. The Kallestad reference also discloses that the insert material serves as a brace behind the tooth, so that a force applied to the tooth is absorbed by the front layer, transmitted through the tooth and then dispersed by the insert material. The Kallestad reference is deficient since it does not disclose that the insert material is positioned in front of the tooth, to transmit an applied force across the front surface of the teeth before the force reaches the tooth, and to reduce the force before it reaches the tooth.

The Jones reference discloses a cold formed mouthguard of expanded PTFE material that includes an outer shell, a force absorbing layer, and an insert. The Jones reference discloses an insert positioned transversely in a lower portion of the outer wall of the mouthguard, and that the insert extends longitudinally the entire length of the mouthguard. The Jones reference is distinguishable from the present application since the insert extends over the entire length of the mouthguard in a longitudinal direction, and only a lower portion of the outer wall in a transverse

direction. The Jones reference does not disclose that the insert material extends between the first molars on each side of the arch in a longitudinal direction, or between the incisal and cervical portion of the tooth in a transverse direction.

The Daskalon reference merely discloses a bonding material layer of fibers in a resin matrix that functions to cover a ceramic bar. The Daskalon reference merely discloses that the bonding layer functions to allow the dental appliance to be shaped, or for another layer to be bonded thereon. The Daskalon reference is deficient since the bonding layer functionally provides a bonding surface within a dental restoration, and is not a force transmitting layer in a mouthguard.

In order to make a *prima facie* case of obviousness, the Examiner must provide an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988 CA Fed. 2006) The Applicant respectfully submits that the Examiner has not met this burden and is using the Applicant's application as a template to combine these unrelated references through a hindsight reconstruction of Appellant's claims. (*Ex parte Crawford et al.*, Appeal 20062429 decided May 30, 2007). The bonding layer described in the Daskalon reference performs a completely different function than the force transmitting layer in the present application. The insert and outer wall of the Jones reference transmits the forces in a totally different manner than the present invention. The structure and function of the mouthguard in the Kallestad reference is distinguishable from the present invention.

Therefore, the mouthguard of the present application is not predictable in light of the prior art, since the selected elements of the prior art do not perform the same function in combination as they did separately. The present application discloses a unique combination of a

force transmitting layer of a fibrous material in a resin matrix with a force absorbing layer that yields a mouthguard that is lighter, less cumbersome to wear, and offers effective protection. The Applicant has previously submitted an affidavit of the inventor stating the advantages of the present invention and the resulting commercial success.

Therefore, the Applicant respectfully submits that claims 1 and 13, and the claims dependent therefrom, are distinguishable over the prior art, since the Office has failed to sufficiently articulate why one of ordinary skill in the art would have been motivated to make the asserted combination.

Based on the above, Applicant submits that the claims are in a condition for allowance, which allowance is respectfully solicited. If the Examiner finds to the contrary, it is respectfully requested that the undersigned in charge of this application be called at the telephone number given below to resolve any remaining issues.

Dated: 10/15/07

Respectfully submitted,

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